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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,771	12/09/1999	R. MARTIN EMANUELE	19720-0624	8054

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EXAMINER

SCHNIZER, RICHARD A

ART UNIT PAPER NUMBER

1635

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/457,771

Applicant(s)

EMANUELE ET AL.

Examiner

Richard Schnizer, Ph. D

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) 1,23,25 and 27-31 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 37.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4,6,7,9-12,14,15,18,19,21-25,27-36 and 38-42.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: Claim 22 as amended is not fully enabled/described. Claim 22 formerly depended from claim 9, and further limited claim 9 by restricting the scope of nucleic acid molecules of claim 9 to those that could be used "for hybridization with one or more targeted RNA messages of a cell." This limitation effectively excluded the nucleic acid molecule species "genes" because genes are double stranded DNAs that are not used for hybridization to messages. However, as amended, claim 22 now requires that "genes" must be useable for hybridization with one or more target RNAs. The specification as filed does not contemplate this method or teach how to perform it.

Claims 36 and 38 as amended would be objected to because parent claim numbers 35 and 37 are referred to in quotations.

Claim 40 is indefinite because it depends from cancelled claim 9.

Claims 3 and 36 were to be amended to require that the molecular weight of the hydrophobe portion of the copolymer is between approximately 4400 and 14,000 Daltons. Claim 41 was to be amended to recite a hydrophobe molecular weight range of 4740-14,000 Da. The specification provides no written support for these specific ranges, and there is no evidence that Applicant contemplated a range limited by 4400 and 14,000 Da, or a range limited by 4740 and 14,000 Daltons, at the time the invention was filed. Applicant argues that the specification supports these ranges because it discloses copolymers with hydrophobic portions of approximately 4400, 4740, 5900, 7500, 10000, and 14000 Da. This is unpersuasive because there is no evidence or logic to indicate that Applicant intended to set the specific range limitations that are recited in the proposed amendments at the time of the invention. As a result, these ranges are new matter, and the amendment is not entered. Similar arguments apply to proposed claims 32, 33, 35, and 36, as stated in the Final Rejection of 3/22/05. These claims recite ranges that lack written support in the specification as filed.



Richard Schnizer
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Art Unit 1635